

### REMARKS

In the Office action, pending claims 11-18 are allowed and claims 19-27 stand rejected. Previously submitted claim 19 was rejected under 35 U.S.C. § 102(b) as being anticipated by Apps et al. (U.S. Patent No. 6,006,677) and Gronnevik (U.S. Patent No. 5,845,588). Previously submitted claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gronnevik. Previously submitted claims 20, 21, and 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gronnevik in view of Ford et al. (U.S. Patent No. 6,228,914).

The examiner also noted that the Declaration under 37 C.F.R. § 1.132 sets forth "secondary considerations" that are not relevant in addressing an obviousness rejection. The examiner also rejected the Declaration because "there is no factual evidence of the stated opinions, such as testing results."

As an initial matter, Applicant submits that the examiner's failure to consider the content of the Declaration violates the procedures set forth in the MPEP. The MPEP expressly states that "[a]lthough factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue." See MPEP § 716.01(c). Accordingly, the MPEP expressly states that Applicant is entitled to have the examiner consider the evidence set forth in the Declaration.

The examiner also mischaracterized the evidence as being evidence of "secondary considerations." The evidence set forth

in the Declaration is extrinsic evidence that addresses the content of the prior art. Specifically, the Declaration includes thirteen paragraphs that illustrate why the five references that were cited against the claims do not teach or suggest all of the limitations of claims 19-27. See Declaration ¶¶ 12-24. Accordingly, the Declaration includes more than mere evidence of secondary considerations.

The evidence in the Coleman Declaration is relevant to the examiner's rejections because the examiner relied upon the inherency doctrine to assert that Apps and Gronnevik anticipate claim 19. The MPEP states that the examiner must provide a rationale or evidence tending to show inherency. MPEP § 2112. The MPEP also indicates that once the examiner makes an inherency argument, an applicant has the right "to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product." *Id.* Accordingly, the examiner must follow the MPEP and consider the evidence set forth in the Coleman Declaration, as it addresses the examiner's inherency doctrine argument as opposed to presenting evidence of secondary considerations.

The evidence set forth in the Coleman Declaration also addresses the examiner's purported *prima facie* case of obvious. The MPEP expressly states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations" to establish a *prima facie* case of obviousness. MPEP § 2142. Since the evidence set forth in the Coleman Declaration

addresses the content of the purported prior art references, the evidence is directed to the *prima facie* case of obviousness, not the secondary considerations.

Assuming *arguendo* that the evidence contained in the Coleman Declaration was directed to secondary considerations, Applicant notes that claims 20, 21, and 23-27 were rejected under 35 U.S.C. § 103(a), not 35 U.S.C. § 102(b). Accordingly, the Examiner's assertion that "[s]econdary considerations are not relevant to anticipation under [35 U.S.C. § 102]" does not establish that the evidence contained in the Coleman Declaration is not relevant to the obviousness rejections set forth in the Office action. Accordingly, the examiner has an obligation to consider the evidence set forth in the Coleman Declaration.

Also, 37 C.F.R. § 1.132 clearly indicates that the scope of evidence that may be submitted in a declaration under 37 C.F.R. § 1.132 is broad, as follows:

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

37 C.F.R. § 1.132. Accordingly, there was nothing inherently objectionable or improper about the type of evidence that was submitted in the Coleman Declaration.

Regarding the rejection of claim 19 as being anticipated by Apps et al. or Gronnevik, neither reference discloses nor suggests all of the elements of claim 19 because neither reference discloses a fire resistant layer formed on the outer

surface of a pallet.

Apps et al. has been reviewed and, as understood, discloses a plastic pallet having an anti-slip layer that is provided by scuffing the outer surface. Apps et al. does not disclose or suggest a fire resistant layer. See also Muirhead Dec. ¶¶ 5-6.

Gronnevik has been reviewed and, as understood, discloses a multi-layer structure in which a polyolefin material is coated with an anti-slip layer of EVA or EBA. See column 5, lines 54-55. Gronnevik does not disclose or suggest a fire resistant layer.

Since neither Apps et al. nor Gronnevik discloses or suggests a fire resistant layer, the examiner has invoked the inherency doctrine to assert erroneously that "plastics including thermoplastic material provide a fire resistant layer." Office action at 2. However, the evidence of record does not support the examiner's assertion, as indicated by the Coleman Declaration and the Muirhead Declaration. See Coleman Dec. ¶¶ 12-19; Muirhead Dec. ¶¶ 7-11.

Indeed, the Coleman Declaration indicates that at least one of the references, the McGrath reference, directly contradicts the examiner's position. Coleman Dec. ¶ 14. The Coleman Declaration also indicates that the McGrath reference refers to "fire safe" polymers, not "fire resistant" plastics, and that the term "fire safe" has a very specific definition to a person of ordinary skill in the art. See Coleman Dec. ¶ 15. Accordingly, the Coleman Declaration establishes that the McGrath reference does not support the examiner's contention that all plastics provide fire

resistance.

The Coleman Declaration also indicates that the Vinyl Institute reference would be of limited value to a person of ordinary skill in the art because it relies upon ASTM standards, which include the following disclaimer:

"This standard should be used to measure and describe the fire response of materials, products, or assemblies to heat and flame under controlled laboratory conditions and should not be used to describe or appraise the fire-hazard or fire risk of materials, products, or assemblies under actual fire conditions. However, results of this test may be used as elements of a fire-hazard assessment or a fire risk assessment which takes into account all of the factors which are pertinent to an assessment of the fire hazard or fire-risk of a particular end use."

Coleman Dec. ¶ 18 (citing Annual Book of ASTM Standards 2006, Vol. 8.01, D 2843 p. 714 ¶ 1.4). Accordingly, the Coleman Declaration indicates that there is no support in the record for the examiner's assertion that Apps et al. and/or Gronnevik inherently disclose fire resistant layers.

The Coleman Declaration also indicates that the problems that are addressed in Gronnevik (i.e. plastic pallets that have an outer surface with a low coefficient of friction) are unrelated to the inherent lack of fire resistance of plastic materials. See Coleman Dec. ¶ 22.

Applicant further submits that Gronnevik does not teach or suggest all of the limitations of claim 22 because Gronnevik does not teach or suggest a fire resistant layer formed on the outer surface of a pallet. Accordingly, the rejection of claim 22 for obviousness over Gronnevik should not stand for the reasons set

forth above.

Regarding the examiner's rejection of claims 20-21 and 23-27 over Gronnevik in view of Ford et al., Ford et al. has been reviewed and, as understood, discloses an aqueous intumescent composition that is applied by conventional coating methods, such as spraying, dipping, drawing, and brushing to a structure after its formation. See Ford et al., Col. 12, lines 1-8. Ford et al. does not teach or suggest that the disclosed intumescent composition can be co-extruded with a polyolefin base material.

Indeed, the Coleman Declaration indicates that Gronnevik cannot be combined with Ford et al. because Ford et al.:

discloses an aqueous intumescent composition, which is not suitable for melt processing in a co-extrusion process. As a result, a person of ordinary skill in the art is unlikely to combine the Gronnevik patent with the Ford patent to produce a polyolefin patent having an intumescent layer through a co-extrusion process. The Ford coating is not formulated for compatibility with polymer melts; it is a coating that is formulated to bond to rough surface materials as described in the examples. The coating is applied to an existing surface. This Ford coating is a thermoset polymer that cannot be melt processed once it is heated to the curing temperature. Thus, it is totally unsuitable for extrusion or co-extrusion.

Coleman Dec. ¶ 24. Accordingly, Gronnevik and Ford et al. cannot be combined to render claims 20-21 and 23-27 obvious. See also Muirhead Dec. ¶¶ 12-13.

Applicant further submits that claim 22 includes the limitations of claim 20, so that the above reasoning with respect to claims 20-21 and 23-27 applies to claim 22, as well.

Applicant also notes that claim 19 of the instant application interferes with claim 14 of U.S. Patent No. 6,758,148

by Torrey et al. The relevant statute indicates that a claim that is directed to the same or substantially the same subject matter of a claim in an issued patent may not be made more than one year after the issuance of that patent. 35 U.S.C. § 135(b)(1). Accordingly, an interference must be declared between claim 19 of the instant application and claim 14 of Torrey et al. for the reasons set forth in Applicant's December 1, 2006 Office action.

The amendment does not include new matter.

The rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) have been traversed and claims 11-27 are in condition for allowance. Accordingly, in view of the above amendments, explanations, and remarks, reconsideration and allowance of claims 11-27, as amended, is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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